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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,539	01/29/2001	R. Kyle Webb	12082-05/JWE	9234
26271	7590	01/29/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			FARAH, AHMED M	
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HOUSTON, TX 77010-3095				
ART UNIT 3739 PAPER NUMBER 16				
DATE MAILED: 01/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/772,539</b>	Applicant(s) <b>Web et al.</b>
Examiner <b>Ahmed M. Farah</b>	Art Unit <b>3739</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)  Claim(s) 1-40 is/are pending in the application.

4a) Of the above, claim(s) 29-40 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1 and 15-21 is/are rejected.

7)  Claim(s) 2-14 and 22-28 is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5-9

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of invention I in Paper No. 11 is acknowledged.
2. Claims 29-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made without traverse in Paper No. 11.

### ***Specification***

3. The abstract of the disclosure is objected to because it is improper and does not comply with 37 CFR 1.72. The abstract contains 213 words contains. Correction is required. See MPEP § 608.01(b).

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 09/896,429. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to analogous interfaces adapted to couple a patient's eye to a surgical laser system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lai U.S. Patent No. 5,549,632.

Lai discloses ophthalmic surgery apparatus and method of use for determining and controlling the location of interaction point between a patient's eye and surgical laser beam, the apparatus comprising:

an interface 109 adapted to couple the patient's eye to a surgical laser 100 (see Fig. 1);  
attachment means 115 adapted to overlay the anterior surface of the eye to provide stable engagement to the eye (see Fig. 1);  
an applanation lens 111 mounted to the attachment means (see Fig. 4C), the applanation lens having an applanation surface configured to contact the eye; and  
a gripper (suction ring 501) adapted to the bottom surface of the interface so as to stabilize the position of the interface relative to the operative area of the eye, the gripper further including a central orifice for receiving the lens.

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Lai further discloses an annular suction cavity disposed in a portion of the attachment means, and a fluid communication channel coupled between the suction cavity and a vacuum source (see Fig. 4C, and column 13, lines 6-10).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 15-17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Burba et al. U.S. Patent No. 6,436,113 B1.

As to the limitation “flexible attachment,” although Lai teaches an articulated arm having flexible joints (see claim 4) and his gripper (suction ring 501) conforms to the shape of the eye, he does not particularly teach that the suction ring overlying the anterior surface of the eye is flexible. As to claim 17, Lai does not teach the specifics of the vacuum source.

However, Burba et al. teach an alternative ophthalmic surgical device in which the attachment means overlying the eye is flexible (see column 4, lines 44-46). As to claim 17, Burba et al. further teach the use of a vacuum source comprising a spring-loaded syringe coupled to the attachment ring by tubing as presently claimed (see Fig. 4, and column 6, lines 27-59).

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Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Lai in view of Burba et al. and use a flexible attachment means overlying the eye being treated so as to accommodate automatically to slight differences in the shape of the eye surface. This would also reduce any damage that a rigid attachment means may have inflicted on the ocular tissue. It would have been further obvious to use a vacuum source comprising a spring-loaded syringe so as to generate vacuum. The use of spring-loaded vacuum syringes to generate pressure gradient is well known in the medical art.

10. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Burba et al. as applied to claims 1, 15-17, 20, and 21 above, and further in view of Yavitz U.S. Patent No. 6,247,473 B1.

Although both Lai and Burba et al change the ocular pressure of the eye (for example, see column 3, lines 32-39 of Burba et al.), they do not particularly teach the range of the pressure developed against the eye.

Yavitz discloses an ophthalmic device in which a vacuum source is used to develop ocular pressures of up to 70 mm Hg against the eye as presently claimed. Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Lai in view of Burba et al. and in further view of Yavitz to develop ocular pressures of up to 70 mm Hg so as to fix/stabilize the surgical device against the eye.

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*Allowable Subject Matter*

11. Claims 2-14 and 22-~~28~~ are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references: U.S. Patent No. 5,336,215 to Hsueh et al; U.S. Patent No. 5,997,559 to Ziemer; U.S. Patent No. 5,009,660 to Clapham; and U.S. Patent No. 6,676,653, U.S. Patent No. 6,623,476 B2, and 6,373,571 B1 to Juhasz et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak, can be reached on (703) 308-0994. The official fax number for the group is (703) 872-9302; the fax number for After Final is (703) 872-9303; and the Examiner's Desk-top fax is (703) 746-3368.

**A. M. Farah**

**Patent Examiner (Art Unit 3739)**

January 25, 2004.

